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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,215	03/04/2002	Adrienne Elizabeth Dubin	ORT-1601	5197
75	90 12/23/2004		EXAMINER	
Philip S. Johnson, Esq.			LOCKARD, JON MCCLELLAND	
Johnson & Johnson One Johnson & Johnson Plaza			ART UNIT	PAPER NUMBER
New Brunswick, NJ 08933-7003			1647	
			DATE MAILED: 12/23/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

	·	Application No.	Applicant(s)	
		10/090,215	DUBIN ET AL.	
	Office Action Summary	Examiner	Art Unit	
		Jon M Lockard	1647	
Period fo	The MAILING DATE of this communication ap or Reply	pears on the cover sheet wit	h the correspondence address	
A SH THE - Exte after - If the - If NO - Failu Any	ORTENED STATUTORY PERIOD FOR REPL MAILING DATE OF THIS COMMUNICATION. nsions of time may be available under the provisions of 37 CFR 1. SIX (6) MONTHS from the mailing date of this communication. period for reply specified above is less than thirty (30) days, a rep of period for reply is specified above, the maximum statutory period are to reply within the set or extended period for reply will, by statutive reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	136(a). In no event, however, may a rely within the statutory minimum of thirty will apply and will expire SIX (6) MONTe, cause the application to become AB/	ply be timely filed (30) days will be considered timely. HS from the mailing date of this communication. NDONED (35 U.S.C. § 133).	
Status				
	Responsive to communication(s) filed on 22 C. This action is FINAL . 2b) This Since this application is in condition for allowed closed in accordance with the practice under the condition of t	s action is non-final. nce except for formal matte	•	
Dispositi	ion of Claims			
5) <u></u> 6)⊠	Claim(s) 11 and 23 is/are pending in the appli 4a) Of the above claim(s) is/are withdra Claim(s) is/are allowed. Claim(s) 11 and 23 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or	wn from consideration.		
Applicati	ion Papers	,		
10)⊠	The specification is objected to by the Examine The drawing(s) filed on <u>04 March 2002</u> is/are: Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Example 2.	a) accepted or b) objective or b) to object or accepted or b) objection is required if the drawing(s	e. See 37 CFR 1.85(a). b) is objected to. See 37 CFR 1.121(d).	
Priority (ınder 35 U.S.C. § 119			
a)l	Acknowledgment is made of a claim for foreign All b) Some * c) None of: 1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority application from the International Burea See the attached detailed Office action for a list	is have been received. Is have been received in Aprity documents have been in the contract of	plication No eceived in this National Stage	
Attachmen	t(s)			
1) Notice 2) Notice 3) Inform	te of References Cited (PTO-892) te of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) r No(s)/Mail Date 3/4/02, 10/12/04.	_ Paper No(s)	mmary (PTO-413) /Mail Date ormal Patent Application (PTO-152) ence Alignment.	

DETAILED ACTION

Status of Application, Amendments, And/Or Claims

- 1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1647, Examiner Jon Lockard.
- 2. Claims 11 and 23 are pending.
- 3. The previous examiner indicated allowable subject matter in an Interview on 21 October 2004. Allowability is withdrawn. Rejections are applied below.

Information Disclosure Statement

4. The Information Disclosure Statements (IDS) submitted on 04 March 2002 and 12 October 2004 have been considered by the Examiner.

Drawings

5. Applicants are advised that upon issuance of a patent, the complete text of the sequence listing submitted in compliance with 37 C.F.R.§§1.821-1.825 will be published as part of the patent. Therefore, it is unnecessarily redundant to repeat the sequence information in the form of Figures. Applicants should amend the specification to delete any Figures (e.g. Figures 1-8, for example) which consist only of nucleic acid or protein sequences which have been submitted in their entirety in computer readable format (i.e. as SEQ ID NO:'s) and should further amend the specification accordingly to reflect the replacement of the Figure by the appropriate SEO ID NO.

Specification

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "Human vanilloid receptor VR3 protein".

Claim Rejections - 35 USC § 101 and 35 USC §112

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 9. Claims 11 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific, substantial, and credible asserted utility or a well established utility. Novel biological molecules lack an established utility and must undergo extensive experimentation to determine an appropriate specific, substantial, and credible utility.
- 10. The instant application discloses a polypeptide set forth as SEQ ID NO:12. The Specification teaches that SEQ ID NO:12 is one of three isoforms of the putative human vanilloid receptor identified as VR3A+B+ (See page 7, lines 26-27). The specification asserts that predicted amino acid sequence of VR3A+B+ set forth as SEQ ID NO:12 displays sequence homology and structural homology to the vanilloid receptor family (VR1 and VR2) (See page 8,

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lines 15-20 and page 49, line 28 – page 50, line 6). The only experimental data or information provided by the Instant Specification on whether the putative VR3A+B+ protein (SEQ ID NO:12) functions like an ion channel is the disclosure that oocytes injected with VR3A+B+ RNA demonstrated enhancement of a heat-induced response (measured by whole cell currents) compared to controls (See Figure 10, page 5, line 17 – page 6, line 15). However, mere homology and a showing of increased responsiveness to heat would not be accepted by those of skill in the art as being predictive of function. For example, the Specification teaches that VR1 is activated by capsaicin and RTX, and activation of VR1 is blocked by the antagonists capsazepine and ruthenium red (See page 1, line 28 – page 2, line 2). However, the Instant Specification discloses that oocytes injected with VR3A+B+ RNA (encoding the claimed protein of SEQ ID NO:12) demonstrated no detectable differences in membrane conductance when compared to controls when challenged with a variety of ligands (including capsaicin and RTX),

Table 1). Therefore, the Specification's assertion that SEQ ID NO:12 functions as member of the vanilloid receptor family is not a substantial assertion of utility, since significant further

low pH, and depolarizing as well as hyperpolarizing voltage steps (See page 41, lines 22-25,

the valimoid receptor failing is not a substantial assertion of utility, since significant further

research would be required of the skilled artisan to determine the function and/or biological

activity of the putative receptor. There is no well-established utility for a specific nucleic acid or

amino acid sequence, and the specification fails to disclose a specific and substantial utility for

the claimed invention.

11. The specification asserts the following as patentable utilities for the claimed VR3

receptor protein (SEQ ID NO:12):

1) useful to identify modulators of the VR3 receptor (pg 3, lines 19-20);

- 2) identify agonists and antagonists (pg 4, lines 1-2);
- 3) production of antibodies (pg 22, line 4 pg 25, line 8); and
- 4) pharmaceutical compositions as therapeutics (pg 27, line 5 pg 32, line 29);
- 12. These asserted utilities are neither specific nor substantial because they do not identify or reasonably confirm a "real world" context of use. The specification neither identifies the biological functions of the claimed protein, nor any diseases that are associated with the claimed molecules. Without any biological activity or link to a disease, further research would be required to determine the properties of the claimed VR3 protein of SEQ ID NO:12 or to identify a disease that can be treated or diagnosed with the claimed molecules, which is insufficient to meet the requirement of 35 USC § 101.
- 13. These activities and functions are conjectural and are based solely on the identification of the putative protein of SEQ ID NO:12 as being a vanilloid receptor. While it is credible that SEQ ID NO:12 is a member of the TRP/vanilloid family of ion channels, its identification as such is not sufficient to establish either a well known, or a specific, substantial and credible utility. The negative results of the functional assays presented in the Specification are not indicative of any function, and no disease or disorder is correlated with the polypeptide. The use of a putative ion channel to discover its biological properties does not constitute a specific, substantial utility, but rather is further experimentation to determine the properties of that which is being claimed
- 14. The art teaches that the TRP/vanilloid family is large and there is no unifying theme to their function or mechanism of activation. Furthermore, members of the TRP family are widely distributed across a range of cell types, making it difficult to express confirmed monomeric channels, and several TRPs are known to form heteromulitmers and their electrophysiological

properties depend on the subunit composition. (Clapham et al. [2001]. Nature Reviews Neuroscience 2:387-396). Furthermore, the Specification of the Instant Application discloses that "although these novel nucleic acids and proteins display some sequence and structural homology to the TRP and vanilloid families of cation channel proteins as well as other cation channel proteins known in the art, it is also known in the art that proteins displaying such homologies have significant differences in function, such as conductance and permeability, as well as differences in tissue expression." Thus, although the homology of the TRP/vanilloid family, especially in the 6 transmembrane domain regions containing a short hydrophobic stretch between transmembrane regions 5 and 6, allows identification of such as both TRPs and as being evolutionarily related, such is not predictive of function. It is possible that, after further characterization, this protein might be found to have a patentable utility, in which case proteins would have a specific utility, or the protein might be found to be associated with a specific disease.

15. In Brenner v. Manson, 148 U.S.P.Q. 689 (Sup. Ct., 1966), a process of producing a novel compound that was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be useful because the compound produced thereby was potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The instant claims are drawn to a protein which has undetermined function or

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biological significance. Until some actual and specific activity or significance can be attributed

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to the protein identified in the specification as SEQ ID NO:12, the claimed invention is

incomplete.

16. Claims 11 and 23 are also rejected under 35 U.S.C. 112, first paragraph. Specifically,

since the claimed invention is not supported by either a specific, substantial and credible asserted

utility or a well established utility for the reasons set forth above, one skilled in the art clearly

would not know how to make/use the claimed invention.

Claim Rejections - 35 USC § 112, 2nd paragraph

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 11 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

19. Claim 11 is indefinite for reciting "an amino acid sequence set forth in SEQ ID NO:12"

in line 2 of the claim. Without knowing whether the indefinite article "an" is intended to mean

"the amino acid sequence of SEQ ID NO:12" or any portion of the amino acid set forth as SEQ

ID NO:12, the metes and bounds of the claim cannot be determined.

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20. Claim 23 is indefinite because it is not clear whether "has" means "comprises, in which case the claim is not further limiting, or "consists of". Amendment to the claim to use the more precise "consists of" is suggested.

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 22. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Masters et al. (WO 01/34805, published 17 May 2201; priority date 12 November 1999).
- 23. Masters et al. teach a polypeptide set forth as SEQ ID NO:3 (See Figure 8) that comprises an amino acid sequence that shares 100% identity with residues 1-736 of SEQ ID NO:12 of the Instant Application (See attached sequence alignment). It is noted that the term "comprising an amino acid sequence", as recited in the claim is open language reading on a fragment, and thus the claim reads on the polypeptide taught by Maters et al. (See also 112¶2 rejections *supra*). Thus, the reference of Masters et al. meets all the limitations of claim 11.

Summary

24. No claim is allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jon M. Lockard**, **Ph.D.** whose telephone number is (571) 272-2717. The examiner can normally be reached on Monday through Friday, 8:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Brenda Brumback**, **Ph.D.** can be reached on (571) 272-0961.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML

December 16, 2004

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Location/Qualifiers
238. .269
/label= Ankaryn_rep
                                                                                                                                                                                                                                                receptor 3 (hVR3) protein.
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Ankaryn_repeat

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Gaps

KRWRKKIIEKQPQSPKAPAPQPPPILKVFNRPILFDIVSRGSTADLDGLLPFLLTHKKRL

180 180 120 120 60

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                                                                                                               Query Match
Best Local Similarity
Matches 736; Conserv
                                                                                                                                    The present sequence is human vanilloid receptor 3 (hVR3) protein. Vanilloid receptor protein and its DNA are useful for identifying compounds which modulate vanilloid receptors in human tissues, which he will be useful for treating various disease states, including neuropathic pain, inflammation, arthritis, rhinitis, pruritus, bladder dysfunction, cluster headache, wound healing and psoriasis. Vanilloid receptor DNA is useful as standard or reagent in diagnostic immunoassays, as targets for pharmaceutical screening assays and also in gene therapy. Vanilloid receptor protein is useful for detecting the presence of anti-vanilloid receptor derived polypeptide in test samples. Vanilloid receptor antibodies are useful for detecting vanilloid receptor polypeptides, for screening for diseases or conditions associated with abnormal vanilloid receptor production, treating disorders involving capsaicin-sensitive ion channels and as diagnostic markers
                                                                                                                                                                                                                                                                                                                                                                           Novel human vanilloid receptor gene and encoded polypeptides for identifying compounds that modulate vanilloid receptors in human tissuand for treating inflammation, arthritis, psoriasis and wound healing.
                                                                                                               Sequence 871 AA;
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N-PSDB; AAD05107.
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AAGESTAT 4
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           Nucleic acid encoding human
                                                             WPI; 2001-596911/67.
N-PSDB; AA166972, AA166973.
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                                                                                                                       receptor 3 (VR-3) and VR-5,
5 and for treating calcium
and pain disorders.
                                                                                                                               useful for screening modulators of VR-3 or VR homeostasis related disorders (e.g. dementia)
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aim 13; Fig 2A-C; 167pp; English.

The invention provides nucleic acid encoding human ion channels referred to as Vanilloid receptor 3 (VR-3) and VR-5. The VR-3 or VR-5 proteins can be used to screen for naturally occurring VR-3 or VR-5 ligands or for drugs or compound which modulate VR-3 or VR-5 activity. The VR-3 or VR-5 proteins and their modulators (e.g. antisense nucleic acids and anti-VR antibodies) are useful for treating disorders characterized by insufficient or excessive production of VR-3 or VR-5. These disorders are calcium homeostasis related disorders (Alzheimer's disease, dementia, Parkinson's disease), pain disorders (Alzheimer's disease, dementia, arthritis) and/or cellular growth and/or proliferation disorders (e.g. cancer). Numerous other examples of these disorders are given in the specification. The present sequence represents the human VR-5 Sequence 871

Query Match
Best Local Similarity
Matches 736; Conser 361 301 301 661 601 601 541 541 481 481 421 421 361 241 241 181 181 121 121 61 5 KRWRKKIIEKQPQSPKAPAPQPPPILKVFNRPILFDIVSRGSTADLDGLLPFLLTHKKRL GDGRPNLRMKFQGAFRKGVPNPIDLLESTLYESSVVPGPKKAPMDSLFDYGTYRHHSSDN RDSETFSTFLLDLFKLTIGMGDLEMLSSTKYPVVFIILLVTYIILTFVLLLMÅLIALMGE NSLFIDGSFQLLYFIYSVLVIVSAALYLAGIBAYLAVMVFALVLGMMNALYFTRGLKLTG AMVIFTLTAYYQPLEGTPPYPYRTTVDYLRLAGEVITLFTGV NLEAVLNNDGLSPLMMAAKTGKIGIFQHIIRREV ALHIAIERRCKHYVELLVAQGADVHAQÅRGRFFQPKDEGGYFYFGELFLSLAACTNQPHI GDGRPNLRMKFQGAFRF MADSSEGPRAGPO MADSSEGPRAG TYSIMIQKILFKDLFFFLLVYLLFMIGYASALVSLLNPCANMKVCNED(AMVIFTLTAYYQPLBGTPPYPYRTTVDYLRLAGEVITLFTGVLFPFTNIKDLFMKKCPGV LSSLDTCGERASVLBILVYNSKIENRHEMLAVEPINELÅRDKWRKFGAVSFYINVVSYLC NLEAVLNNDGLSPLMMAAKTGKIGIFOHIIRREVTD VNYLTENPHKKADMRRQDSRGNTVLHALVAIADNTRENTKFVTKMYDLLLLKCARLFPDS VNYLTENPHKKADMRRODSRGNTVLHALVAT TDEEFREPSTGKTCLPKALLNLSNGR TDEEFREPSTGKTCLPKALLNLS **ALHIAI ERRCKHYVELLVAQGADVHAQAR** TYSIMIQKILFKDLFRFLLVYLLFMIGYASALVSLLNPCANMKVCNEDQ LSSIDTCGBBASVLBILVYNSKIENRHEMLAVEPINELLR 99.2%; Score 3829; 100.0%; Pred. No. 0; Vative 0; Mismatches GEVAELPGDESGTPGGEAFPLSSLANLFEGEDGSLSPSPADASRPAGP VABLPGDESGTPGGEAFPLSSLANLFEGEDGSLSPSPADASRPAGP VPNPIDLLESTLYESSVVPGPKKAPMDSLFDYGTYRHHSSDN Mismatches NGRNDTI PVLLDI AERTGNMREFINS PFRDI YYRGQT NDTIPVLLDIAERTGNMREFINSPFRDIYYRGQT RFFQPKDEGGYFYFGELFLSLAACTNQPHI ADNTRENTKFVTKMYDLLLLKCARLFFDS MOEDTRHLSRKFKDWAYGPVYSSLYD <u>,</u> **PTRHLSRKFKDWAYGPVYSSLYD** Indels KWRKFGAVSFYINVVSYLC PEFTNI KOLFMKKCPGV PNCTVPTYPSC 0 MILIALMGE 1 300 120 720 660 600 000 540 480 420 360 360 300 240 180 9 660 540 480 420 240 180 120 0

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